

**REMARKS*****Summary of the Response***

By the present response, claims 18 and 30 will have been amended and claim 29 will have been canceled without prejudice or disclaimer. Accordingly, while claims 18 – 28 and 30 – 42 remain pending, claims 39 – 42, directed to the non-elected invention, have been withdrawn from consideration by the Examiner as being drawn to a non-elected invention. By the present amendment and remarks, Applicants submit that the objections and rejections have been overcome, and respectfully request reconsideration of the outstanding Office Action and allowance of the present application.

***Summary of the Office Action***

In the instant Office Action, the Examiner has objected to claims 18 – 38 based upon formal matters and has rejected these claims based upon formal matters and over the art of record. By the present amendment and remarks, Applicants submit that the rejections have been overcome, and respectfully request reconsideration of the outstanding Office Action and allowance of the present application.

***Entry of Amendment is Proper***

Applicants submit that the pending amendment is proper for entry in that no question of new matter and no issues requiring further consideration or search by the Examiner are raised in entering this amendment.

In particular, by the amendment, the subject matter of claim 29 has been incorporated into independent claim 18. As the Examiner has already considered and searched for this combination of features, Applicants submit that no new issues are raised requiring further search if this amendment is entered.

Accordingly, as entry and consideration of the pending amendment is proper, Applicants respectfully request such entry and consideration and an indication of allowance in the next official communication.

***Traversal of Rejection Under 35 U.S.C. § 112, First Paragraph***

Applicants traverse the formal rejection of claims 18 – 38 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. In particular, Applicants traverse the Examiner’s assertions that the original disclosure does not reasonably convey to one ordinarily skilled in the art that the inventors had possession of the invention including the recited coating color distribution chamber at the time the application was filed.

The Examiner’s attention is directed to the second full paragraph on page 8 of the original disclosure (or paragraph [0031] in corresponding U.S. Patent Application Publication No. 2007/0089844), which describes a paper machine that includes “an applicator for applying a *coating color in the manner of a curtain* or for the film application or for spraying coating color on.” [emphasis added] [Specification, p. 8, ll. 14 – 19]. Further, the curtain application of the coating color is detailed in the first full paragraph on page 23 of the original disclosure (or paragraph [0116] in corresponding U.S. Patent Application Publication No. 2007/0089844), which describes a curtain applicator 51 that “comprises a distribution chamber 52 with a discharge nozzle 53, through which an application medium 54 is discharged onto the paper web 36.” [Specification, p. 23, ll. 14 – 17].

Applicants further note that, while the film press and spray coating embodiments of the color coating applicator nozzle only show nozzles 61, 62 (Fig. 4) and 66, 67 (Fig. 5), one ordinarily skilled in the art would readily understand that these nozzles are connected to some sort of coating color supply or containment unit, such as the distribution chamber 51 connected

to nozzle 53, as illustrated in Fig. 3. Thus, Applicants submit that one ordinarily skilled in the art reviewing the original disclosure would readily understand that the nozzles for the film press illustrated in Fig. 4 are connected to some sort of coating color supply unit, such as the distribution chamber, as recited in independent claim 18.

Thus, as the original disclosure provides explicit support for a distribution chamber supplying a coating color to a nozzle, Applicants submit that the original disclosure would reasonably convey to one ordinarily skilled in the art that Applicants had possession of a color coating distribution chamber in combination with the film press, as recited in at least independent claim 18, at the time this application was filed.

Accordingly, Applicants request that the Examiner reconsider and withdraw the formal rejection of claims 18 – 28 and 30 – 38 under 35 U.S.C. § 112, first paragraph, and indicate that these claims are fully in compliance with the requirements of the statute.

***Traversal of Rejection Under 35 U.S.C. § 112, Second Paragraph***

Applicants traverse the formal rejection of claims 18 – 38 under 35 U.S.C. § 112, second paragraph, as being indefinite. In particular, Applicants traverse the Examiner's assertions that the recited term coating color distribution chamber at the time the application was filed.

For the reasons set forth above, Applicants note that one ordinarily skilled in the art reviewing the original disclosure would understand that the film press nozzles 61, 62 illustrated in Fig. 4 are connected to a coating color containment unit that supplies the coating color to the nozzles. Further, it would have been apparent to one ordinarily skilled in the art that, as the distribution chamber illustrated in Fig. 3 contains coating color and supplies the coating color to a nozzle for application of the coating color to the web, the film press nozzles of Fig. 4 would likewise be coupled to a distribution chamber as a coating color containment and supply unit.

Further, as the distribution chamber is provided to contain coating color and supply the same to the nozzles for application to the web, Applicants submit that one ordinarily skilled in the art would readily understand the manner in which the various color coating applicators illustrated in Figs. 3 – 5 operate and that each embodiment, including the film press embodiment, would include a coating color distribution chamber to supply coating color to nozzles 61, 62. Thus, as the original disclosure provides explicit support for a distribution chamber supplying a coating color to a nozzle, Applicants submit that one ordinarily skilled in the art reviewing the original disclosure and the pending claims would readily understand the recited term coating color distribution chamber and the scope of the claims reciting this term.

Accordingly, Applicants request that the Examiner reconsider and withdraw the formal rejection of claims 18 – 28 and 30 – 38 under 35 U.S.C. § 112, second paragraph, and indicate that these claims are fully in compliance with the requirements of the statute.

***Traversal of Rejection Under 35 U.S.C. § 103(a)***

1. *Over Ahonen*

Applicants traverse the rejection of claims 18 – 23 under 35 U.S.C. § 103(a) as being unpatentable over AHONEN et al. (U.S. Patent 6,413,371) [hereinafter “AHONEN”]. Applicants traverse, *inter alia*, the Examiner’s assertion that AHONEN discloses a film press to apply a color coating 500.

With regard to the pending rejection of the claims under 35 U.S.C. § 103(a), Applicants note the Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, Applicants are under no obligation to submit evidence of non-obviousness. To establish a *prima facie* case of obviousness, three basic criteria must be met:

- (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
- (2) there must be a reasonable expectation of success; and
- (3) the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). *See* MPEP §2142.

Further, while rejecting a *rigid* application of the teaching, suggestion, or motivation (“TSM”) test in an obviousness inquiry, the U.S. Supreme Court acknowledged the importance of identifying “a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does” in an obviousness determination. *Takeda Chemical Industries, Ltd. v. Alphapharm Pty., Ltd.*, 492 F.3d 1350, 1356-1357 (Fed. Cir. 2007) (quoting *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1731 (2007)).

Applicants' independent claim 18 recites, *inter alia*, a coating color distribution chamber, and a film press having at least one film roll structured and arranged to apply a coating color supplied by the coating color distribution chamber, such that the coating color has a solids proportion of less than 65% measured in percent by mass. Applicants submit that AHONEN fails to render obvious the above-noted features of Applicants' invention.

Applicants initially note that, while the Examiner asserts that AHONEN discloses a film press to apply a coating color 500, AHONEN provides no express or implied disclosure of

applying a coating color to the web. In fact, Applicants submit that, as AHONEN fails to disclose applying a coating color to the web, one ordinarily skilled in the art would not reasonably expect to achieve the features of the present invention through any obvious modification of AHONEN under 35 U.S.C. § 103(a).

As described by AHONEN, the invention concerns the manufacture of paper “for color powder printing.” [AHONEN, Abstract, ll. 1 – 3]. Further, the background discussion in AHONEN provides that “[o]ne important need is glossy porous paper, which is well suited for colour-powder based printing” [AHONEN, col. 1, ll. 21 – 23], and that “[o]ne problem in printing with a colour copier is inadequate gloss of the paper to be used.” [AHONEN, col. 1, ll. 30 – 32]. AHONEN summarizes that “in colour-powder printing, such a coated or compacted paper is needed as does not adhere to the colour powder fixing unit and in whose use said problem of glass-sheet effect does not occur.” [AHONEN, col. 1, ll. 37 – 40].

Thus, in contrast to the instant invention, which is directed to applying a coating color to a web as part of the manufacture of the web, AHONEN is directed to a machine for manufacturing a paper onto the finished product of which a color powder from a color copier will be applied. In other words, the web according to Applicants’ invention has a coating color applied during the manufacturing process, while the post manufactured, i.e., finished product of AHONEN will receive color toner when used in a color copier.

While the finished product of AHONEN, i.e., color copier paper (where “color” refers to the copier not the paper), is intended to receive color powder (i.e., toner) in a printing process within a color copier, AHONEN fails to provide any express or implied disclosure of applying a coating color via film press 500 or any other structure or process within the disclose manufacturing process of AHONEN. Further, while the Examiner has asserted AHONEN

discloses coating color, the Examiner has not identified any subject matter in AHONEN in support of his assertion.

In this regard, AHONEN discloses a film size press 500 to provide a coating agent onto the face of the paper web. [AHONEN, col. 6, ll. 51 – 55]. However, rather than disclosing that this coating agent is a *coating color*, as recited in the pending claims, AHONEN merely discloses that the coating agent is applied to provide the best porosity. [AHONEN, col. 6, ll. 56 – 64]. There is no apparent or suggested disclosure of coating color, as recited in at least Applicants' independent claim 18.

Because AHONEN fails to disclose or suggest at least the above-noted features of independent claim 18, Applicants submit this document cannot even arguably render obvious the combination of feature recited in Applicants' claims.

Thus, for the foregoing reasons, Applicants submit that the pending rejection of independent claim 18 is improper and should be withdrawn. However, in an effort to advance prosecution, Applicants have further amended independent claim 18. In particular, Applicants' independent claim 18 now additionally recites, *inter alia*, the coating color has a solids proportion of less than 65% measured in percent by mass, which is neither disclosed nor suggested by AHONEN.

As AHONEN fails to disclose a coating color, as recited in at least independent claim 18, Applicants submit that this document cannot even arguably be understood to suggest the recited solids proportion of the coating color, as now additionally recited in at least independent claim 18.

Because AHONEN fails to disclose or even suggest the above-noted features recited in at least independent claim 18, as currently presented, Applicants submit that the invention recited

in at least independent claim 18 would not have been apparent or obvious to one ordinarily skilled in the art reviewing the disclosure of AHONEN. Accordingly, Applicants request that the Examiner reconsider and withdraw the rejection of independent claim 18 in indicate the allowability of the same in the next official communication.

Further, Applicants respectfully submit that claims 19 – 23 are allowable at least for the reason that these claims depend from allowable base claims and because these claims recite additional features that further define the present invention. In particular, Applicants submit that no proper modification of AHONEN can render obvious the combination of features recited in at least claims 19 – 25, 28, and 30 – 38.

Further, Applicants submit that claim 22 is separately patentable over AHONEN in that the applied art fails to disclose a float dryer arranged between the film press and the calender. While the Examiner asserts “impingement dryer 450 reads on a float dryer with hot air,” Applicants submit that the Examiner has not addressed each of the features of claim 22 as recited. That is, while expressly requested in Applicants’ previous response, the Examiner still has not identified how he has interpreted the dryer 450 of AHONEN to be “arranged between the film press and the calender.” As such, as discussed further below, Applicants respectfully submit that the Examiner has not presented a complete action or a clear record.

Moreover, Applicants submit that a careful review of AHONEN’s figures reveal the impingement dryer 450 is not arranged between the film press and the calender. Rather, as shown in Figure 1, the impingement dryer 450 is arranged upstream of both the film press and the calender. As such, Applicants submit AHONEN does not disclose each of the features of claim 22, and does not anticipate the present invention.

Further, Applicants submit that claim 28 is separately patentable over AHONEN in that the applied art fails to disclose a float dryer arranged between the film press and the calender. While the asserting “the float dryer comprises a thermal radiation generator,” the Examiner has not positively identified the recited structure in the applied art of AHONEN. As such, as discussed further below, Applicants respectfully submit that the Examiner has not presented a complete action or a clear record.

Further, Applicants submit that claim 28 is separately patentable over AHONEN in that the Examiner has not presented a complete action or a clear record. While Applicants’ claim 28 recites, *inter alia*, the film press is structured and arranged to operate with a coating color having a binder system comprising starch, the Examiner merely states, “[AHONEN] disclose coating color,” without providing any specific authority in AHONEN to support his allegation. Thus, Applicants respectfully disagree with the Examiner and again expressly request that the Examiner clarify his interpretation of AHONEN with regard to this and all pending claims.

Thus, for at least these reasons, Applicants submit that AHONEN does not teach or suggest the features of claim 28, and does not render the present invention unpatentable.

Further, despite Applicants’ express request for clarification, the Examiner still has not addressed any of the features recited in at least claims 31 – 35. As such, as discussed further below, Applicants respectfully submit that the Examiner has not presented a complete action or a clear record. Moreover, as claims 31 – 35 recite features of a metering rod, and as the Examiner has not identified any structure described in AHONEN that would be construed by one ordinarily skilled in the art as a metering rod, Applicants submit that AHONEN does not teach or suggest the features of claims 31 – 35, and does not render the present invention unpatentable.

Further, Applicants submit that AHONEN does not teach or suggest the features of claim 36, which recites, *inter alia*, the at least one film roll has a diameter of more than 1500 mm, such that this claim is separately patentable over AHONEN.

While the Examiner states, “[i]t would have been obvious that the film roll be structured to be of a diameter that would provide for process and product results,” Applicants respectfully submit that the Examiner has not properly addressed the features of claim 36. As such, as discussed further below, Applicants respectfully submit that the Examiner has not presented a complete action or a clear record.

Moreover, Applicants submit that AHONEN does not teach or suggest the at least one film roll has a diameter of more than 1500 mm. In fact, Applicants submit that AHONEN is completely silent as to the dimensions of the film rolls of the film size press section. Thus, Applicants submit that AHONEN does not teach or suggest the features of claim 36, and does not render the present invention unpatentable.

Accordingly, for at least the above reasons, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 18 – 25, 28, and 30 – 38 under 35 U.S.C. § 103(a) and indicate that these claims are allowable.

2. Over Ahonen in view of Meschenmoser

Applicants traverse the rejection of claims 26 and 27 under 35 U.S.C. § 103(a) as being unpatentable over AHONEN in view of MESCHENMOSER (U.S. Patent 6,406,596).

Applicants note that MESCHENMOSER fails to teach or suggest any of the subject matter noted above as deficient in AHONEN. That is, MESCHENMOSER fails to provide any teaching or suggestion for modifying AHONEN so as to apply a coating color to the web, as

recited in at least independent claim 18, or of applying a coating color having a solids proportion of less than 65% measured in percent by mass, as is now recited in at least independent claim 18.

Thus, Applicants submit that no proper combination of AHONEN and MESCHENMOSER can render unpatentable the combination of features recited in at least independent claim 18, as currently presented, such that the pending rejection should be reconsidered and withdrawn.

Further, Applicant respectfully submits that claims 26 and 27 are allowable at least for the reason that these claims depend from an allowable independent claim, and because these claims recite additional subject matter to further define the instant invention.

Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 26 and 27 under 35 U.S.C. § 103(a) and indicate that claims 26 and 27 are allowable.

***Complete Action Not Provided***

Applicants respectfully submit that the Examiner did not provide a complete action, and as such, Applicants submit that the next action should not be a final action. As set forth above, Applicants submit that with regard to claims 23 and 31 – 35, the Examiner has not addressed any of the features of these claims, and with regard to claims 22 and 36, the Examiner has not properly addressed each of the features as recited.

Thus, Applicants submit that a clear record was not provided and a clear issue was not developed between Applicants and the Examiner. More specifically, MPEP §706 states:

Before final rejection is in order a clear issue should be developed between the examiner and applicant. To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied; and in reply to this action the applicant

should amend with a view to avoiding all the grounds of rejection and objection.

Additionally, MPEP 706.07(a) notes:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). ...

Furthermore, a second or any subsequent action on the merits in any application ... will not be made final if it includes a rejection, on newly cited art, other than information submitted in an information disclosure statement filed under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17 (p), of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art.

Accordingly, Applicants respectfully request that the Examiner properly address the features of claims 22, 23 and 31 – 36, such that a clear issue is developed between the Examiner and Applicants. Moreover, Applicants respectfully submit that the next action, which should clarify the record, cannot be a final action.

#### CONCLUSION

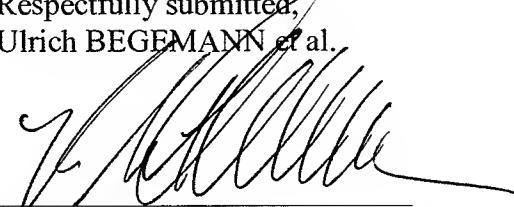
In view of the foregoing, it is submitted that none of the references of record, either taken alone or in any proper combination thereof, anticipate or render obvious Applicants' invention, as recited in claims 18 – 28 and 30 – 38. The applied references of record have been discussed and distinguished, while significant claimed features of the present invention have been pointed out.

Accordingly, reconsideration of the outstanding Office Action and allowance of the present application and all of the claims therein are respectfully requested and now believed to be appropriate.

Should there be any questions, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Authorization is hereby given to charge any fees necessary for the consideration of this amendment to deposit account No. 19-0089.

Respectfully submitted,  
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